

Appl. No. 09/994,199  
Amd. Dated January 17, 2005  
Reply to Office Action Dated September 17, 2004

### REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Claims 1-38 remain in this application. Claims 1 and 12 are amended herein.

#### Claim Objections

Claims 1 and 12 stand objected to because of certain informalities. Applicant has amended Claims 1 and 12 herein. It is believed that these amendments obviate the rejections. No new matter has been added by way of these amendments.

#### Rejection(s) under 35 U.S.C § 103(a)

Claims 1-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Abercrombie (US 4,605,065) in view of Freitas (US 4,928,760) alone and/or in combinations with Waterman (US 5,627,749), Williams (US 4,688,638), GB23444365 and/or Monel. Applicant respectfully traverses the rejection.

#### **a. Legal Background**

In the present case, the Examiner has rejected the claims on the grounds of obviousness under 35 U.S.C. § 103. It is well established that, before a claim may be rejected, the Examiner carries the significant burden of establishing a *prima facie* case of obviousness. According to MPEP § 706.02(j), for a claim to be rendered obvious, there must be: a) a suggestion or motivation to combine reference teachings, b) a reasonable expectation of success, and c) the

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references must teach all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

To support a claim of obviousness, the Examiner cannot rely on Applicant's disclosure to generate the requisite motivation. *See In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991)(teaching or suggestion to make the claimed combination must be found in the prior art, not applicant's disclosure). The Examiner also cannot rely on hindsight reconstruction in support of an obviousness type rejection. *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d (BNA) 1566, 1568-69 (Fed. Cir. 1990) (vacating and remanding Board holding of obviousness). Where the prior art teaches away from Applicants' invention, there can be no suggestion to combine the prior art references to achieve Applicants' invention. *See Tec Air, Inc. v. Denso Mfg. Michigan, Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

The Court of Appeals for the Federal Circuit has held time and again that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *In re Bond*, 910 F.2d at 834, 15 U.S.P.Q.2d at 1568, *quoting Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 U.S.P.Q. (BNA) 644, 647 (Fed. Cir. 1986) (affirming holding of nonobviousness); *see also, e.g., In re Stencel*, 828 F.2d 751, 755, 4 U.S.P.Q.2d (BNA) 1071, 1073 (Fed. Cir. 1987) (reversing Board holding of obviousness); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. (BNA) 929, 933 (Fed. Cir. 1987) (reversing district court holding of obviousness). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992).

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According to the Federal Circuit, if the suggestion to combine prior art references is missing (as in this case), it is unlikely that the missing suggestion can be supplied through a showing of the level of ordinary skill in the art. *See Al-site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 40 USPQ2d 1161 (Fed. Cir. 1999). Moreover, the Federal Circuit has indicated that what may have been within the knowledge of one of skill in the art is insufficient absent clear and convincing evidence that one of ordinary skill in the art actually possessed such knowledge. *See Smiths Indus. Med. Sys., Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). In fact, the Federal Circuit has reversed a decision by the Board of Patent Appeals & Interferences for hindsight reconstruction where the Board failed to cite specific information in the prior art that would suggest the combination of the prior art references. *See In re Dembiczak*, 173 F3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

**b. Response to Examiner's Arguments**

As indicated above, the case law does not permit the Examiner to use hindsight and/or selective dissection of the references in order to obtain Applicant's invention. The Examiner has ignored the teachings of the references as a whole in making the proposed combinations, and failed to show any motivation for combining the cited references. Applicant, therefore, reiterates its arguments against the combination of the cited references in view of the divergent teaching and application of the combined references.

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**c. Claim Rejections**

In the instant case, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 for any of the claims at issue.

There is no motivation to combine Abercrombie with Freitas. In fact, the teachings of Freitas would deter one skilled in the art from making such a combination. According to Freitas, coupons should be mounted substantially flush with the surface of the elongated member in which it is placed to prevent turbulence. *See Freitas, Col. 2, lines 63-68.* In contrast, Abercrombie teaches a well tubing mandrel (13) with a side pocket (27) offset from the main bore (25). *See Abercrombie, Figs. 1-4 and Col. 3, lines 4-6.* This configuration by Abercrombie places the coupon 59 in the direct path of the flow of fluid. This 'offset' position appears to be in direct conflict with repeated statements in Freitas which require that the coupons be positioned in recesses in the tool to reduce any damage to the coupon. *See Freitas, Col. 1, lines 14-16, lines 20-26; Col. 2, lines 63-68 and Col. 3, lines 58-60.* In view of the conflicting teachings of Abercrombie and Freitas, one of skill in the art would be deterred from such a combination. As discussed in the legal background section above, it goes against the teachings of the Federal Circuit for the Examiner to selectively dissect portions of Abercrombie and Freitas in an attempt to obtain Applicant's invention. Thus, the combination of Abercrombie and Freitas fails to support a *prima facie* case of obviousness. Additionally, the Examiner has failed to demonstrate any motivation to combine Abercrombie and/or Freitas with any of the remaining art of record.

Any attempt to combine Abercrombie with Freitas (or any of the other art of record) would still not achieve Applicant's invention. The Examiner concedes that Abercrombie fails to disclose a formation evaluation tool, but somehow concludes that Freitas does. There is no

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disclosure in Freitas that the tool 10 is a formation evaluation tool. According to Freitas, the tool 10 is merely positioned in the wellbore 20, and does not contact, penetrate or otherwise interact with the formation surrounding the wellbore. Typically, formation evaluation tools take samples of fluid from or measure properties of the surrounding formation. Freitas fails to show a tool that performs such formation evaluation. The remainder of the art of record also fails to teach any type of formation evaluation tool. Thus, the art of record fails to teach at least one limitation of the pending claims and, therefore, fails to support a prima facie case of obviousness.

For at least these reasons, Applicant respectfully submits the art of record fails to render obvious any of Applicant's Claims. Moreover, Applicant respectfully submits that none of the art of record teaches, discloses or even suggests Applicant's claimed invention. Applicant, therefore, requests withdrawal of the rejection Applicant's Claims under 35 U.S.C. § 103 based on the cited art.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned at the telephone number listed below.

This paper is submitted in response to the Office Action dated September 17, 2004 for which the three-month date for response is December 17, 2004. A one-month extension of time is requested, bringing the due date for response to January 17, 2005. The Commissioner is authorized to charge Deposit Account 50-2898 with \$120.00 for the one-month extension of time. Please apply any charges not covered, or any credits, to Deposit Account 50-2898 (Reference Number 20.2756).

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Date:

1/17/05

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